

REMARKS

Prior to this Request for Continued Prosecution, a Final Office Action was mailed April 12, 2011.

Claims 29-33 and 39-59 are pending, claims 29, 31, 50, and 59 are in independent form. No new claims are added.

In the Final Office Action dated 04/12/11 the Examiner rejects applicant's pending claims 29-31, 33, 40-55 & 57-59 under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (U.S. 6,587,835 B1 hereinafter, Treyz '835) in combination with Van Ruzin et al. (U.S. 6,255,911 B1 hereinafter, Van Ryzin '961) as applied to claim 29, further in view of Tari et al., (U.S. 6,542,491 B1 hereinafter, Tari '491), and further in view of Anderson et al. (U.S. 20020087622, hereinafter, Anderson '622).

At least each independent claim 29, 31, 50 and 59 has been amended to clarify the subject matter over the cited references to facilitate examination. Reconsideration is requested.

Examiner Interview was conducted September 13, 2011 regarding the effective priority date of certain prior art references Anderson.

INTERVIEW SUMMARY

In the previous office filed January 31, 2011, Applicant asserted the following:

\*\*\*\*\*

**1. Anderson is not available as prior art (whether under USC 102 or 103):**

*As a preliminary matter, applicant submits that Anderson is NOT available as prior art against the present application. The earliest effective filing date for Anderson is December 29, 2000.*

*The present application is a continuation-in-part of U.S. Patent Application No. 09/992,413 filed November 18, 2001, which claims the benefit of U.S. Provisional*

*Application No. 60/252,682 filed November 20, 2000. Accordingly, Anderson was filed after the U.S. Provisional Application No. 60/252,682.*

*Applicant believes that each claim element that the examiner asserts as having been disclosed by Anderson can be found in Provisional Application No. 60/252,682. A listing of the support for the elements cited by the examiner in Anderson is shown in the Priority Table below.*

*Because Anderson is not available as prior art for the elements cited, applicant respectfully requests that the examiner withdraw the §103 rejection of any element in a claim for which he relies on Anderson, either alone or in combination with any other reference, including Tari.*

### **1.2 SUPPORT FOR CLAIMS FROM PROVISIONAL APPLICATION 60/252,682**

*Applicant asserts that each claim element that the examiner asserts as having been disclosed by Anderson is supported by the Provisional Application No. 60/252,682. The Priority Table included below maps each of those claims elements to Provisional Application No. 60/252,682.*

<b>Priority Table</b>	
<b>Claim Elements</b>	<b>Examples of Support in 60/252,682</b>
Information apparatus	(Page 1, line 10-17), Fig 1 (100)
Mobile wireless information apparatus	(Page 1, line 10-17), (Page 2, line 21-23), Fig 1 (100)
Touch sensitive screen at the Information apparatus	(Page 4, line 27), (Page 9, line 5)
Digital Content	(Page 1, line 7 ), (Page 9, line 8)
local wireless communication or a wireless local area network	(Page 10, line 18-23), (Page 24, line 10-14), (Page 31, line 12-14 ), (Page 37, line 17-19), (Page 5, line 17-21)
Wireless communication unit	(Page 11, line 8-19), (Page 16, line 23), (Page 27, line 18), Fig 2A, 2B
Short range wireless communication	(Page 24, line 23), Fig 2A, 2B
IEEE802 and Bluetooth™	(Page 30, line 13), (Page 11, line 15), (Page 11, line 30), (Page 24, line 12)
Operating system	(Page 7, line 7), (Page 27, line 26)
Object and or component model	(Page 7, line 7), (Page 27, line 26)

<i>Output device</i>	(Page 1, line 17-24), Fig 1 (106), Fig 3 (3A, 3B, 3C)
<i>Television</i>	(Page 11, line 27), (Page 29, line 24)
<i>Output controller</i>	(Page 25, line 35-33), Fig 1 (106), Fig 3 (3A, 3B, 3C)
<i>Wireless output device</i>	Fig 3 (3A, 3B, 3C)
<i>Searching over wireless</i>	(Page 27, 29-33), (Page 28, 1-2), Fig 5
<i>Discovering over wireless</i>	(Page 27, 29-33), (Page 28, 1-2), Fig 4 (402, 404), Fig 5
<i>Receiving an information from discovered wireless output devices</i>	(Page 35, line 3-8), Fig 5
<i>selecting, at the wireless information apparatus, a wireless output device</i>	(Page 27, 29-33), (Page 28, 1-2), Fig 4 (402, 404), Fig 5
<i>Conforming/generating output data</i>	(Page 43, line 12-14), (Page 24, line 1), (Page 16, line 5), Fig 8 (804)
<i>Compression</i>	(Page 43, line 12-14), (Page 24, line 1), Fig 8 (804)
<i>Encryption</i>	(Page 43, line 12-14), (Page 24, line 8), Fig 8 (804),
<i>Authentication</i>	(Page 34, line 29-32), (Page 35, line 10-25)
<i>In dependence of a successful authentication</i>	(Page 34, line 29-32), (Page 35, line 10-25)
<i>Billing/payment</i>	(Page 35, line 27-33)
<i>Broadcast availability</i>	(Page 31, line 6-14)

\*\*\*\*\*

Nonetheless, Examiner issued a final rejection dated 4/12/11 citing Anderson despite the traversal by the applicant shown above. An interview was requested to ascertain the priority date with the examiner.

At the Interview, the Examiner takes that position that the priority date of the instant is as was placed on the Application at the time of filing (January 31, 2001) because this priority date is of record. Applicant takes the position the proper priority date, as amended in his specification on 01/27/11, is November 20, 2000. Examiner communicated his intent to double-check his position with Quality Assurance Personnel, and communicate to the undersigned his position that 37 CFR 1.78 limits an Applicant making such reference to a commonly owned invention.

Applicant disagrees with the position that in this Request for Continued Examination filed pursuant to 37 CFR 153(d) that the Director of Patents may have been over-restrictive in its application statutory provision, 35 U.S.C. § 120 **re: Benefit of earlier filing date in the United States.**

Applicant pointed out in the Interview that applicable M.P.E.P. Rule 201.08, implementing 35 U.S.C. § 120, "**Continuation-in-Part Application**" is applicable in this case:

"Accordingly, an alleged continuation-in-part application should be permitted to claim the benefit of the filing date of an earlier nonprovisional application if the alleged continuation-in-part complies with the following formal requirements of 35 U.S.C. 120: ...at least one common inventor; The alleged continuation-in-part application was filed before the patenting or abandonment of or termination of proceedings on the first application...; and The alleged continuation-in-part application contains or is amended to contain a specific reference to the earlier filed application."(Emphasis Added).

The two applications at issue, 09/992,413 and 12/053,765, have the at least one common inventor, William Ho Chang; the earlier application is still pending; and the Instant C-I-P Application was amended on 01/27/11 to contain a specific reference to the earlier filed application. Applicant's position is that he is well within his rights to amend as he has done, and the prior art reference at issue, Anderson '531, does not have priority, as the Instant has an earlier priority date than this reference.

\*\*\*\*\*

However, in an effort to expedite present application to a speedy conclusion and in further view that the cited reference (Anderson) does not teach nor suggested the elements recited in the claims whether alone or in combination (as already communicated to the examiner in the traversal on January 31, 2011), Applicant has provisionally agreed to amended the specification herein to remove the reference to the co-pending application to facilitate examiner review and allowance. Applicant reserves

the right to amend the specification to reference the co-pending application as a continuation-in-part of present application in future office actions. And Applicant reserves the right to file a Petition to the Director to overcome objection by the Examiner.

**1. Anderson teaches a different subject matter:**

In the previous office action dated January 31, 2011, In addition of submitting that Anderson is not a prior art, Applicant further traversed the cited reference as follows:

\*\*\*\*\*

Anderson teaches an online website for providing photo services. User device 12 accesses the Internet via a service provider 16 to access the online site (See Abstract of Disclosure; Summary of Invention; and Fig. 1)

Anderson does not teach or describe "*the transferring of the output data over the short range wireless connection not including transferring the output data over the Internet or via the Internet*". Instead, Anderson emphasizes that the connection must be connected to the Internet for uploading and downloading data to the online photo service site.

Following Anderson, one of ordinary skill in the art will specifically be instructed to connect to the Internet and NOT over a short range wireless connection that does not include transferring the output data over the Internet or via the Internet.

For this reason alone, Anderson is not an applicable reference whether alone or in combination with anything including Tari for describing a short range wireless connection that does not include transferring the output data over the Internet or via the Internet.

The Examiner agrees that neither Anderson nor Tari teaches or describes

IEEE802.11 or Bluetooth as recited in each independent claim.

Because of the explicit teaching by both Anderson and Tari to communicate by connecting to the Internet, Anderson cannot be combined with any other reference under §103 to teach one of ordinary skill a short range wireless communication that removes or excludes the Internet from Anderson or Tari, while keeping the remaining disclosure unchanged or unaffected.

Anderson explicitly teaches communication using the Internet. Neither Anderson nor Tari suggest anything related to removing the Internet for communication. Accordingly, one of ordinary skill will not be led or motivated to modify Anderson or Tari to remove the Internet. Furthermore, a combination of Tari and Anderson with anything to remove the Internet communication from the system of Anderson or Tari as suggested by the examiner will produce unexpected results or a result that will predictably make the system of Anderson or Tari inoperable (without the explicit Internet being included).

\*\*\*\*\*

However, in the final office action dated 4/12/11, the examiner failed to include a rebuttal to the argument raised in the applicant's reply (see MPEP § 706.07) regarding Anderson.

**MPEP § 706.07 states:**

*"Before final rejection is in order a clear issue should be developed between the Examiner and applicant...However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the Applicant's reply." "They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal."*

The office action of 4/12/11 has no answer to the above traversal by the applicant regarding Anderson. Accordingly, the Final Office Action mailed by examiner on 4/12/11 regarding Anderson was Improper.

It would be appreciated that in future office actions if the Examiner would include a rebuttal in accordance **MPEP § 706.07 and MPEP 2144.03**. Which is required so that Applicant may “judge the advisability of an appeal”.

## **2. Treyz**

*Treyz teaches that a user may operate a handheld computing device to provide the user with shopping assistance services over a communication network such as the Internet, or a local wireless link with communication equipment associated with the [retailer's] establishment. (Claims 1, 11, 18; Col. 2, Ins. 13-26; Col. 11, Ins. 31-37; Col. 13, Ins. 39-47).*

*Treyz further describes the shopping assistance service may allow a user to obtain directory information of a shopping mall. Hence, a user may use the handheld computing device for shopping. The handheld computing device may display promotional material and obtain information on products being sold in a store or shopping mall. Treyz describes that the location of the user can be obtained by a GPS or by wireless triangulation for the location of the handheld computing device and therefore the shopping service can provide information and promotion material based on the users' location. (Fig 18; Col. 23, Ins. 36-56).*

*Treyz further describes that the user of the handheld computing device can pay for products and services anywhere such as in amusement park, shopping mall etc. The handheld computing allows the user to perform wireless financial transactions for purchasing products (Fig 10, #162). Treyz describes that the handheld computing device may be used for sending and receiving e-mails, messaging, and for making phone calls. (Col. 16, Ins. 60-63).*

### **2.1 Treyz describes a different subject matter from what is recited claims:**

Treyz describes a different subject matter from what is recited in claim 29. Treyz teaches using “a handheld computing device for shopping”. Treyz does not teach nor describe the subject matter of:

*"transferring digital content from a mobile wireless information apparatus to a wireless output device by short range wireless communication, the wireless output device being associated with a television... the mobile wireless information apparatus being at least one of a smart phone, an Information-Pad, and an Internet-Pad".*

Because Treyz describes a different subject matter, in a different field of art, the rejections made by the Examiner are remarkable and has created many situations to which the Applicant is unable to properly traverse, including:

- (1) Failing to provide supporting evidence (skipping one or more elements or restriction in the claims). It would be appreciated if the Examiner would provide concrete evidence and reasoning for each elements or restriction recited by the Applicant.
- (2) Citing multiple large paragraph sections and multiple Figures in Treyz, without providing any reasoning. However, upon reading of the cited material, these cited sections describe a different subject matter and is nothing akin to what is being recited in the claims.
- (3) Making rejections using merely "conclusory statements" not found in Treyz. Those conclusory statements are neither taught nor suggested in Treyz. Applicant submits that those "conclusory statements" made without any articulated reasoning is based on hindsight teaching of the Applicant's disclosure, "wherein that which only the inventor taught is used against its teacher." It would be appreciated that the Examiner provide concrete evidence from the cited reference, instead of apparent cutting and pasting from Applicant's disclosure (see MPEP § 2144.03.)

Therefore, for at least the above reasons, Applicant is unable to properly traverse many of the Examiner's rejections.

To facilitate examination, Applicant reiterates the following guidelines for convenience:

**STANDARDS FOR 103(a) REJECTIONS**

(1) MPEP § 2131 states :

“[A] claim is anticipated only if each and every element as set forth in the claim is found...The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (Emphasis Added). Moreover, “[e]very element of the claimed invention must be literally present, arranged as in the claim”. *Id.* (Emphasis Added).

“[T]he showing must be clear and particular.” *Id.* Moreover, “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skill in the art.”

*Bausch & Lomb, Inc. v. Barnes-Hind/ Hydrocurve, Inc.*, 230 USPQ 416 (Fed. Cir. 1986).

(2) MPEP § 2143.01(V) states:

“[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). (Emphasis Added). “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious”. *In re Ratti*, 270 F.2d 810, 123 USPQ 349, (CCPA 1959). (Emphasis Added).

MPEP 2145(X) states “an obviousness rejection may not be based on improper hindsight reasoning gleaned from the Applicant’s disclosure”. *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (1971). MPEP § 2142 states: To reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical person of ordinary skill in the art when the invention

was unknown and just before it was made. This would tend be more applicable in the areas of art subject to rapid advances, like in the instant application.

"[T]he very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Id* at 999. (Quoting W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983).)

## **2.2 Treyz 35 U.S.C. § 103 CLAIM REJECTIONS**

For at least the following reasons, Applicant traverses the Examiner's §103 rejections. More specifically, Applicant herein articulates a Response in an element-by-element analysis of multiple claim elements. Applicant asserts that claims 29-33, 39-59 are patentable over the cited prior art.

### **Treyz distinction Example 1:**

Claim 29 recites:

*"the wireless output device being associated with a television...and not associated with a printing device".*

Treyz does not teach or disclose "the wireless output device being associated with a television". Instead Treyz teaches "printing a receipt" at the store (Col 18: lines 34-36).

Examiner cites Automobile PC or the mall as the output device (Fig 1, 2, computer 38, Automobile PC 44). It is well known by one of ordinary skill that computer 38, Automobile PC 44, or the Mall, or the printer at the store for printing a receipt is not associated with a television.

Following Treyz, one skilled in the art would be lead to either "a printing device, a PC, or a Mall" as associated with the output device and will be lead away from

*"the wireless output device being associated with a television...not associated with a printing device" as recited in claim 29.*

**Treyz distinction Example 2:**

Claim 29 recites:

*"selecting over the graphical user interface at the mobile wireless information apparatus a wireless output device associated with the television discovered in the search based at least in part on the received device dependent attributes received over the wireless communication channel from each of the one or more wireless output devices".*

A user interface accessory attached to the handheld computing device of Treyz is not the equivalent of the GUI of the instant where the user selects a desired output device discovered in the search based at least in part on the received device dependent attribute. The user of Treyz, relying upon an Internet based system, selects a product for purchase, and then may restrict the transaction with a user interface attachment, such as a smart card, "or any other suitable approach for verifying the user's identity may be used". (Cols. 17 thru 18) No device dependent attribute related to the television is transferred by an interface by any suitable approach of Treyz.

**Treyz distinction Example 3:**

Claim 29 recites:

*"not including the Internet in between the mobile wireless information apparatus and the wireless output device".*

However, the Examiner failed to provide any evidence that the communication between the (Handheld Computing Device 12) and the (Computer 38) or (Automobile PC 44) does not include the Internet.

The Examiner is silent with regard to the above element; hence, the rejection is

improper. “[A] claim is anticipated only if each and every element as set forth in the claim is found”. (MPEP § 2131) Applicant respectfully requests concrete evidence for the above statement if the Examiner wishes to sustain this rejection.

Applicant notes that in Fig 2, (Handheld Computing Device 12) and (Computer 38) or (Automobile PC 44) are connected by (Communication Network 32). Treyz explicitly teaches that the communication network includes the Internet. (See Fig 19, #262).

Following Treyz, one skilled in the art would be lead to either “include the internet in between” and will be lead away from “*not including the Internet in between*” as recited in claim 29.

Moreover, because of explicit teaching of Treyz to use the Internet for shopping, Treyz cannot be combined with any other reference under §103 to teach the exact opposite “not including the internet” as such modification will disable the principle mode of operation of Treyz.

#### **Treyz distinction Example 4:**

Claim 29 recites:

*“the searching over the wireless communication channel not related to the searching over the Internet or via the Internet”.*

The Examiner Stated:

*“Fig. 13 i.e. Handheld computing device 12 may communicate with a merchant 178 over a local RF wireless link to receive a directory from computer 184...to retrieve a directory, to retrieve product information from a remote database”.*

It is well known to a user skilled in the art that receiving product catalog and price information from a remote computer via the internet is not same as *the “searching over the wireless communication channel not related to the searching over the Internet or via the Internet”*.

Receiving an output device identity attribute is not the same as receiving product

information for a store's on-line catalog.

Following Treyz, one skilled in the art would be lead to either "search the internet" and will be lead away from "*not related to the searching over the Internet or via the Internet*" as recited in claim 29.

Moreover, because of explicit teaching of Treyz to search the Internet, Treyz cannot be combined with any other reference under §103 rejection to teach "NOT search the Internet" as such modification will disable the principle mode of operation of Treyz.

**Treyz distinction Example 5:**

Claim 29 recites:

*"transferring the output data over the short range wireless connection to the selected wireless output device associated with the television".*

The Examiner cites that the (Handheld Computing Device 12) communicates with the (Computer 38 or Automobile PC 44), but fails to provide evidence as to a method of outputting digital content to the selected output devices (Computer 38) or (Automobile PC 44). Treyz '835 teaches a method of assisting shoppers via in-Store Internet connections. Treyz does not teach nor suggest a method for the (Handheld Computing Device 12) for outputting digital content to a selected output device (Computer 38 or Automobile PC 44). Instead Treyz explicitly teaches using the (Handheld Computing Device 12) for shopping (buying product).

**Treyz distinction Example 6:**

Claim 29 recites:

*"the wireless information apparatus including an operating system with one or more client applications facilitated by the operating system".*

The Examiner States:

*"[W]herein the short range wireless connection being compatible with one within IEEE802.11 wireless standard or being one compatible with Bluetooth TM standard (Fig. 4 i.e. Wireless communication circuitry 96 may support ranged remote wireless communications including a Bluetooth RFR connection. Column 15, lines 16-63)".*

Applicant submits that the Examiner cites sections of unrelated materials describing a different subject matter.

It is well known to one skilled in the art that the wireless communication circuitry of Treyz '835 is nothing akin the a wireless information apparatus including an operating system ... wireless information apparatus with one or more client applications facilitated by the operating system.

Moreover, including "operating system in the wireless information apparatus ... and with one or more client applications facilitated by the operating system" would add cost to Treyz's handheld, and thus one skilled in the art would not be motivated to make add such features of the add an operating system.

### **3. Van Ryzin**

Van Ryzin teaches a wireless Infra-Red remote control for controlling a A/V Devices such as recorders and CD players. The remote control can be synchronized data with a PC via infrared or by wired docket. The PC with access to the Internet for downloading data such as a TV guide. The remote control can store a small amount of data such at the time to record a program by Synchronizing with the PC. The remote control can then control the recorder to record a TV program.

#### **Van Ryzin distinction Example 1:**

Claim 29 recites:

*"the mobile wireless information apparatus being at least one of a smart phone or an Internet-Pad, and*

*the mobile wireless information apparatus including:*

*an operating system,  
one or more client application(s) running at the mobile wireless information apparatus facilitated by the operating system included in the mobile wireless information apparatus,  
a touch sensitive screen,  
a graphical user interface over a touch sensitive screen of the mobile wireless information apparatus for interacting with a user".*

Examiner cites:

The remote control is the mobile information apparatus.

However, Applicant notes that:

- Van Ryzin does not teach nor disclose a smart phone or an Internet-Pad instead it teaches an infra-red remote controller.
- Van Ryzin does not teach nor disclose the infra-red remote controller includes an operating system.
- Van Ryzin does not teach nor disclose the infra-red remote controller includes one or more client application(s) facilitated by the operating system
- Van Ryzin does not teach nor disclose the infra-red remote controller includes a touch sensitive screen, or
- a graphical user interface over a touch sensitive screen of the mobile wireless information apparatus for interacting with a user.

Following Van Ryzin one of ordinary skilled in the art would:

- Not be motivated to modify the infra-red remote controller to be a smart phone or an Internet-Pad, because it is well known that this adds cost to the infra-red controller.
- Not be motivated to modify the infra-red remote controller to include an operating system, and one or more client application(s) facilitated by the operating system, because it is well known that this adds cost to the infra-red controller.
- Not be motivated to modify the infra-red remote controller to include a touch sensitive screen, because it is well known that this adds cost to the infra-red

controller.

- Not be motivated to modify the infra-red remote controller to include a graphical user interface over a touch sensitive screen of the mobile wireless information apparatus for interacting with a user, because it is well known that this adds cost to the infra-red controller.

Moreover, Van Ryzin further teaches that the PC and not the infra-red remote controller include a GUI, and therefore, following Van Ryzin one of ordinary skill will be lead to add GUI in the PC and will be further teach away from adding GUI to the infra-red remote controller.

### **Van Ryzin distinction Example 2:**

Claim 29 recites:

*"short range wireless communication that is compatible with one within IEEE802.11 wireless standard or being one compatible with Bluetooth™ standard".*

Van Ryzin does not teach nor disclose the infra-red remote controller includes IEEE802.11 or Bluetooth, instead it explicitly teaches infra-red. (See Col 5, lines 7).

Following Van Ryzin one of ordinary skill will be lead to add Infra-red to the infra-red remote controller and will be lead away from adding IEEE802.11 or Bluetooth to the infra-red remote controller.

### **Van Ryzin distinction Example 3:**

Claim 29 recites:

*Selecting at the mobile wireless information apparatus...*

The Examiner States:

*[S]electing at the mobile wireless information apparatus a wireless output device associated with the television discovered in the search bases at least in part on the received device dependent attributes received over the wireless*

*communication channel from each of the wireless output devices (i.e. The user could browse a web page television guide of the Internet on the PC and then select shows to be recorded using the remote control 20. Column 5, lines 40-60)".*

The user browsing a web page television guide of the Internet on the PC is not equivalent to not searching over the Internet for a device dependent attribute of the selected output device of the Instant. And searching over the Internet through a web based television guide and selecting entertainment product by the user cannot teach one skilled in the art to search for a selected output device where Internet means are excluded.

**Van Ryzin distinction Example 4:**

Claim 29 recites:

*"wherein, the mobile wireless information apparatus ...is able to transfer digital content ... without depending on synchronizing the digital content with a personal computer".*

Support for the above can be found in the as filed specification in Parag. [0037, line 12].

Van Ryzin does not teach nor disclose the infra-red remote controller without depending on synchronizing the digital content with a personal computer. Instead it explicitly teaches the infra-red remote controller synchronizes with the PC. (See Col 5, lines 25-40).

Van Ryzin explicitly teaches the remote controller obtaining content (e.g. TV guide) from a PC, or synchronizing content with the PC. (See Col 5 Lines 47-49, lines 52-60, lines 61-64).). Van Ryzin teaches the opposite of Applicant, which is to synchronize the remote controller with the PC 44.

Following Van Ryzin one of ordinary skill will be lead to *synchronizing the digital content with a personal computer* and will be lead away from *not synchronizing the*

*digital content with a personal computer.*

**Van Ryzin distinction Example 5:**

Claim 29 recites:

*"downloading by the mobile wireless information apparatus the digital content from a server over the Internet to the mobile wireless information apparatus, the digital content includes video content".*

Van Ryzin does not teach nor suggest remote control downloading digital content from a server over the Internet. Instead Van Ryzin explicitly teach the PC and not the remote control downloading digital content from Internet (see Col 5 line 30-32) and the remote control synchronize with the PC to get the content from PC.

**4. Combination of Treyz and Van Ryzin**

Van Ryzin cannot be combined with Treyz because it would be obvious one skilled in the art that adding one or more of a smart phone, and an Internet-Pad to remote controller of Van Ryzin would increase the cost of the remote controller, and therefore such a motivation to modify Van Ryzin would not exist.

Van Ryzin cannot be combined with Treyz to include a Graphical User Interface (GUI) on the remote controller of Van Ryzin, as the preferred mode of Van Ryzin implements its GUI through the PC 44. (Col. 6: lines 9-29).

Van Ryzin cannot be combined with Treyz to make modification of downloading at the remote controller of Van Ryzin because of the explicit teaching of downloading digital content from the Internet to the PC, not to the remote controller. (See Fig. 3).

Van Ryzin cannot be combined with Treyz to include IEEE802.11 wireless standard or being one compatible with Bluetooth™ standard because of explicit teaching to one of ordinary skill in the art to include Infra-Red short range wireless

communication means (Col. 4: lines 62-66) and not one within IEEE802.11, nor Bluetooth™. Following Van Ryzin, one of ordinary skill in the art would explicitly implement Infra-Red communication means.

## 5. Tari

Tari teaches wireless communication from a user terminal to the Internet as follows:

*"A ...method for communicating between a user terminal and Internet a wirelessly. It is based on a user terminal having a fixed terminal and a terminal unit so that an Internet connection can be made by way of the terminal unit to an appropriate wireless server. The system has at least one wireless server connected to Internet; and a plurality of wireless station devices connected to the wireless server, and the system communicates wirelessly with the terminal unit of the user terminal" (Tari, Abstract of the Disclosure).*

### Tari distinction Example 1: "not including the Internet":

In the previous office action dated January 31, 2011, Applicant traversed the cited reference as follows:

\*\*\*\*\*

Tari does not teach or describe "*the transferring of the output data over the short range wireless connection not including transferring the output data over the Internet or via the Internet*". Instead, Tari emphasizes that the connection must be connected to the Internet for transfer of any data.

Following Tari, one of ordinary skill in the art will specifically be instructed to implement a wireless connection that connects to the Internet and NOT over a short range wireless connection that does not include transferring the output data over the Internet or via the Internet.

For this reason alone, Tari is not an applicable reference whether alone or in

combination with anything including Anderson for describing a short range wireless connection that does not include transferring the output data over the Internet or via the Internet.

The Examiner agrees that Tari teach or describe IEEE802.11 or Bluetooth as recited in each independent claim. However, because of the explicit teachings by both Anderson and Tari to communicate by connecting to the Internet, Anderson or Tari cannot be combined with any other reference including Evans (US Patent 6,690,918) under §103 to teach one of ordinary skill a short range wireless communication that removes or excludes the Internet from Anderson or Tari while keeping the remaining disclosure unchanged or unaffected.

Anderson and Tari explicitly teach communication using the Internet. Neither Anderson nor Tari suggest anything related to removing the Internet for communication. Accordingly, one of ordinary skill will not be led or motivated to modify Anderson or Tari to remove the Internet. Furthermore, a combination of Tari and Anderson with anything to remove the Internet communication from the system of Anderson or Tari as suggested by the Examiner would produce unexpected results, or a result that would predictably make the system of Anderson or Tari inoperable (without the explicit Internet being included).

\*\*\*\*\*

In the final office action dated 4/12/11, the examiner failed to include a rebuttal to the argument raised in the applicant's reply (see MPEP § 706.07) regarding Tari. The office action of 4/12/11 has no answer to the above traversal by the applicant regarding Tari. Accordingly, the Final Office Action mailed by examiner on 4/12/11 regarding Tari was Improper. The Examiner appears to have merely cut and paste from the previous office action without answering Applicant's traversals.

It would be appreciated that in future office actions if the Examiner would include a rebuttal in accordance with ***MPEP § 706.07 and MPEP 2144.03 which is required for making a proper final rejection.*** So that Applicant may “judge the advisability of an appeal”.

**Tari distinction Example 2: "Authentication"**

In the previous office action dated January 31, 2011, Applicant traversed the cited reference as follows:

\*\*\*\*\*

**Claim 31 recites authentication as follows:**

*"obtaining at the mobile wireless information apparatus a security key from the user for accessing the selected wireless output device;*

*sending at the mobile wireless information apparatus the security key over the wireless communication channel for authenticating access of the mobile wireless information apparatus to the select wireless output device;*

*receiving over the wireless communication channel at least an indication related to a successful security key authentication, and in dependence of a successful security key authentication,*

*establishing a restricted wireless connection between the mobile wireless information apparatus and the selected wireless output device".*

The Examiner appears to rely on Tari column 4, lines 4-14 as disclosing the authentication steps of claim 31. The pertinent part of the cited passage of Tari reads:

*"The terminal unit 5-1 requests from wireless server B3-2 a terminal registration approval and an IP address (refer to (a) in FIG. 2, step S1 in FIG. 3). In response, wireless server B3-2 issues registration approval and an IP address (refer to (a), and step S2 in FIG. 3), thus enabling the terminal unit 5-1 to operate under the wireless server B3-2." (Tari, Col 4, line 7-14)*

As shown, Tari does not describe authentication, nor does it describe each and every step associated with authentication recited in claim 31. For example, Tari does not describe or teach a security key. Applicant submits that it is well known by one of ordinary skill in the art that "a registration approval" is not a security key.

In the present case, applicant respectfully requests further clarification from the examiner of whether "a registration approval" as mentioned by Tari is considered to be,

expressly or inherently, a security key. If the Examiner considers "a registration approval" to be express disclosure of a security key, applicant respectfully requests that the Examiner should explain where Tari expressly states that "a registration approval" is a security key. If the Examiner considers that "a registration approval" is inherently a security key, applicant respectfully requests support in accordance with MPEP § 2112(IV).

\*\*\*\*\*

However, in the final office action dated 4/12/11, the examiner failed to include a rebuttal to the argument raised in the applicant's reply (see MPEP § 706.07) regarding Tari.

The office action of 4/12/11 has no answer to the above traversal by the Applicant regarding Tari. Accordingly, the Final Office Action dated 4/12/11 regarding Tari was Improper.

It would be appreciated that in future office actions if the Examiner would include a rebuttal in accordance **MPEP § 706.07 and MPEP 2144.03**. Which is required so that Applicant may "*judge the advisability of an appeal*".

Applicant further submits that the Examiner cites an unrelated material describing a different subject matter. No underpinning reasoning is provided. It is well known by one of ordinary skill that registration with IP address is not the same subject matter as authentication with a security key.

The Examiner is silent with regard to the above element "security key" and "authentication"; hence, the rejection is improper.

"[A] claim is anticipated only if **each and every element** as set forth in the claim is found.. [t]he identical invention must be shown in **as complete detail** as is contained in the ... claim." (See MPEP § 2131). Applicant respectfully requests concrete evidence for the above statement if the Examiner wishes to sustain this rejection.

**Tari distinction Example 3: Encryption:**

Claims 43 have further been amended to recite:

*"the conforming of the digital content into an output data includes an encryption and/or a decryption operation".*

Applicant submit that neither Anderson, Treyz, Van Ryzin, or Tari teach or describe "the conforming of the digital content into an output data includes an encryption and/or a decryption operation".

However, the Examiner once again cites IP registration in Tari as having taught encryption. Applicant submits that the Examiner cites an unrelated material describing a different subject matter. No underpinning reasoning is provided. It is well known by one of ordinary skill that registration with IP address is not the same subject matter as encryption and/or a decryption operation on digital content.

*"[A] claim is anticipated only if **each and every element** as set forth in the claim is found.. [t]he identical invention must be shown in **as complete detail** as is contained in the ... claim." (see MPEP § 2131). Applicant respectfully requests concrete evidence for the above statement if the Examiner wishes to sustain this rejection.*

**6. Additional distinctions: Touch sensitive display**

Claim 29 recites:

*"the interface including at least a touch sensitive screen, the method comprising: receiving over the touch sensitive interface of the mobile wireless information apparatus at least an indication related to a selected digital content for output".*

The Examiner does not appear to have addressed this element of claim 31 in the Office action. Applicant submits that neither Anderson nor Tari teaches or describes

*"the interface including at least a touch sensitive screen, the method comprising:*

*receiving over the...interface...at least an indication related to a selected...content for output"*

*Treyz does not teach nor suggest:*

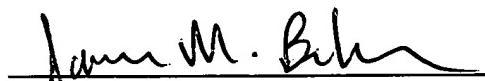
*"receiving over the touch sensitive interface of the mobile wireless information apparatus at least an indication related to a selected digital content for output".*

Whether alone or in combination. If the Examiner considers that any reference discloses or suggests this step of claim 29, Applicant respectfully requests that the Examiner provides support and clarification so that Applicant may properly traverse a rejection in a future Office action.

\*\*\*\*\*

For at least the above REASONS, Applicant respectfully requests Reconsideration, and submits that the claims, as amended, are in a condition for allowance, and the Applicant respectfully request the same.

Respectfully Submitted,

  
James M. Baker  
Reg. No. 47,207

James M. Baker  
Law Office of John G. Humphrey  
6329 NE Sandy Blvd.  
Portland, Oregon 97213  
(503) 287-8805